

REMARKS

I. STATUS OF CLAIMS

Claims 55-60, 71-74, and 93-96 are currently pending in the application. Claims 1-54, 61-70, and 75-92 have been cancelled. These remarks are submitted in response to the rejection of claims 55-60, 71-74, and 93-96 in the final Office Action dated March 30, 2009 (hereinafter, “Office Action”).

II. STATUS OF AMENDMENTS

Claims 95 and 96 have been amended in response to the claim objections in the Office Action. As described further below, the amendments to claims 95 and 96 render the claim objections moot. In view of the final status of the present application, Applicant respectfully submits that the amendments to claims 95 and 96 should be entered as the amendment 1) places the application either in condition for allowance or in better form for appeal; 2) raises no new issue of new matter; and 3) presents no new issues requiring further consideration or search. *See 37 CFR 1.116; see also Manual of Patent Examining Procedure (M.P.E.P.), 8th Ed. § 714.12-13.*

III. GROUNDS OF OBJECTION AND REJECTION TO BE REVIEWED

The grounds of objection and rejection to be reviewed are as follows:

Claims 95 and 96 are objected to due to informalities.

Claims 55, 57-60, 71-74 and 93-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,409,602 to Wiltshire et al. (hereinafter, “Wiltshire”) in view of U.S. Patent No. 6,089,975 to Dunn (hereinafter, “Dunn”).

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiltshire in view of Dunn, and further in view of U.S. Patent No. 5,917,725 to Thacher et al. (hereinafter, “Thacher”).

IV. ARGUMENTS

A. The objection to claims 95 and 96 should be withdrawn.

Claims 95 and 96 are objected to due to informalities. The Office Action objected to claim 95 for reciting “The gaming system of Claim 73” where claim 73 recites “The method of Claim 71.” Similarly, the Office Action objected to claim 96 for reciting “The gaming system of Claim 74” where claim 74 recites “The method of Claim 71.” The objections have

been rendered moot by the amendments to claims 95 and 96. In particular, claim 95 now recites “The method of Claim 73” and claim 96 now recites “The method of Claim 74.” As such, claims 95 and 96 are now directed to the same statutory categories of invention as claims 73 and 74, respectively. Accordingly, withdrawal of the rejection is in order and is respectfully requested.

In view of the final status of the present application, Applicant respectfully submits that the amendments to claims 95 and 96 should be entered as the amendment 1) places the application either in condition for allowance or in better form for appeal; 2) raises no new issue of new matter; and 3) presents no new issues requiring further consideration or search. *See* 37 CFR 1.116; *see also* M.P.E.P. § 714.12-13.

B. The rejection of claims 55, 57-60, 71-74 and 93-96 under 35 U.S.C. § 103(a) as being unpatentable over Wiltshire in view of Dunn should be withdrawn.

Claims 55, 57-60, 71-74 and 93-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiltshire in view of Dunn. Applicant respectfully traverses the rejection because Wiltshire and Dunn cannot be combined to establish sufficient grounds for a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

1. The combination of Wiltshire and Dunn fails to teach or suggest each and every element recited by independent claims 55 and 71.

One basic requirement for a *prima facie* case of obviousness under 35 U.S.C. § 103(a) is that the prior art references must teach or suggest each and every element recited by the claims. *See, e.g.*, M.P.E.P. § 2143. In addition, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Applicants respectfully request that the rejection of the claims under 35 U.S.C. § 103(a) be withdrawn, because neither Wiltshire nor Dunn teaches or suggests displaying a plurality of game selection indicia corresponding to a plurality of games on a remote display terminal after the remote display terminal has been idle for a predetermined period of time, as recited by independent claims 55 and 71.

In particular, claim 55 recites, *inter alia*, “in response to the at least one remote display terminal being idle for a predetermined period of time, the display displaying a plurality of game selection indicia corresponding to the plurality of games.”

Correspondingly, independent claim 71 recites, *inter alia*, “in response to the at least one remote display terminal being idle for a predetermined period of time, displaying a plurality of game selection indicia corresponding to the plurality of games.”

The Office Action acknowledges that Wiltshire fails to teach each and every element of claims 55 and 71. In particular, the Office Action explains:

Wiltshire does not appear to teach displaying a plural game selection indicia corresponding to plural games after the display terminal is idle for a predetermined period of time; and displaying the selected game until the display terminal has been idle for a predetermined period of time, wherein the outcome is disposed on the display of the display terminal as claimed.

Office Action, p. 5, line 4-p. 6, line 24. Thus, the Office Action asserts that the deficiencies of Wiltshire can be cured by the teachings of Dunn. *See* Office Action, p. 6, line 5-p. 8, line 5. Dunn, however, fails to teach or suggest displaying a plurality of game selection indicia corresponding to the plurality of games. Although Dunn may disclose providing a display on an electronic gaming apparatus when the apparatus is not being actively operated by a game player, the display during this inactive period is limited to promotional advertising. According to Dunn:

Thus, the system and gaming apparatus of the present invention, as described hereinbefore and as illustrated in FIGS. 1, 2 and 3 of the drawing sheets, provides casino and gaming establishment owners and operators with a unique means of interactively advertising and promoting the full features and facilities of the casino or establishment at a vast number of display points therein via idle gaming machines. The present system and apparatus also provides customers of the casino or establishment with a wide variety of information respecting other entertainment opportunities, tourist attractions, shopping facilities, traffic and travel information, and other information of current or future interest.

Dunn, col. 6, lines 22-34. The displays in Dunn are intended to provide purely *commercial* information, *i.e.*, advertising and promotions for “the full features and facilities of the casino or establishment” as well as “other entertainment opportunities, tourist attractions, shopping facilities, traffic and travel information, and other information of current or future interest.” *Id.* As such, not only does Dunn fail to teach or suggest displaying a plurality of game selection indicia corresponding to the plurality of games, Dunn fails to teach or suggest displaying information regarding *any* aspect of game play on the apparatus.

The Office Action asserts that:

. . . one of ordinary skill in the art would have understood that promotional advertisements or informational presentations, which incorporate images for selection by the game player for accessing promotions, may also incorporate other selectable images for game play in order to give the game player the option to re-activate game play after shopping during the period in which the game machine/display is inactive.

Office Action, p. 7, lines 15-20. Applicant respectfully submits, however, that the Office Action's assertion is conclusory, because the Office Action fails to provide any evidence that satisfactorily establishes how the display of selectable game play images is related to, or suggested by, the display of the promotional advertisements taught by Dunn. The courts have established that the reasoning behind an obviousness rejection "should be made explicit." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.")); *see also M.P.E.P. § 2142*. In this case, however, the Office Action does not provide the explicit reasoning that connects the concept of promotional advertisements to the concept of selectable images for game play.

The Office Action suggests that one of ordinary skill in the art would incorporate selectable images for game play "to give the game player the option to re-activate game play after shopping during the period in which the game machine/display is inactive." Office Action, p. 7, lines 19-20. However, the Office Action does not explain why a plurality of game selection indicia corresponding to a plurality of games would be specifically necessary to re-activate game play. Indeed, Dunn explains that the display of promotional advertisements "may be periodically interrupted for program rest periods whereupon the electronics of the gaming machine 60 returns the idle video screen display to a showing of normal game-end display subject matter such as the last game hand of cards." Dunn, col. 5, lines 63-67. Thus, Dunn teaches that game play can be re-activated periodically, *i.e.*, at particular time intervals without requiring selectable images for game play.

Furthermore, the Office Action appears to provide an inaccurate reading of Dunn. The Office Action asserts that the promotional advertisements of Dunn "incorporate images for selection by the game player for accessing promotions." Dunn, however, does not teach or suggest that the game player can select images to access promotions. Rather, Dunn teaches that the "interface board 48 is activated thereby transmitting to the video screen 50, in cyclic and/or period program sequences, the promotional advertising and information presentations selected by the casino (or other gaming establishment) owner/operator." *Id.*, col. 5, lines 56-60. Therefore, promotional advertisements in Dunn are videos that are preselected by the owner/operator and displayed repeatedly in a static sequence without any input by the game player. *See id.* Accordingly, because Dunn does not teach or suggest

selectable advertisements, Dunn provides even less suggestion for employing selectable game play images than the Office Action asserts.

Accordingly, both Wiltshire and Dunn provide insufficient grounds for rejecting independent claims 55 and 71, because they each fail to teach or suggest displaying a plurality of game selection indicia corresponding to the plurality of games when a display terminal has been idle. Thus, withdrawal of the rejection of claims 55 and 71 is in order and is respectfully requested. According to the *M.P.E.P.*, “[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” *M.P.E.P.* § 2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, dependent claims 57-60, 72-74, and 93-96 are also allowable based at least on their dependency on claims 55 and 71.

2. The teachings of Wiltshire and Dunn cannot be combined to achieve the claimed invention.

According to the *M.P.E.P.*, “The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success.” *M.P.E.P.* § 2143.02 I. Additionally, the *M.P.E.P.* explains that “at least some degree of predictability is required.” *M.P.E.P.* § 2143.02 II. Applicant respectfully submits that there is no evidence that the results of combining the teachings of Wiltshire and Dunn would have been sufficiently predictable to produce the inventions claimed by claims 55 and 71. The Office Action asserts that Wiltshire discloses the selection of a game according to displayed game selection indicia. *See* Office Action, p. 5, lines 19-23. Specifically, Wiltshire teaches that a casino floor image with selectable casino games is displayed on a computer gaming system when a user activates the computer gaming system by touching the surface of a display screen. *See* Wiltshire, col. 8, lines 42-65. Meanwhile, as described previously, Dunn teaches that promotional advertising is displayed on an electronic gaming apparatus when the apparatus is not being actively operated by a game player. Thus, a combination of these teachings would actually yield a gaming system that 1) displays promotional advertising *when the system is not being actively operated by a user*, and 2) displays selectable game indicia *after the system has been activated by a user via the touch screen*. In other words, the system would not show the selectable game indicia while the system is inactive, as required by the claimed invention. Because combining the teachings of Wiltshire and Dunn would fail to predictably achieve the claimed invention, the Office Action has failed to establish a *prima*

facie case of obviousness. Thus, withdrawal of the rejection of claims 55, 57-60, 71-74 and 93-96 is in order and is respectfully requested.

3. The teachings of Wiltshire and Dunn cannot be combined without modifying the principle of operation of Dunn.

According to the *M.P.E.P.*, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *M.P.E.P.* § 2143.01 VI. Applicants respectfully submit that combining the teachings of Wiltshire and Dunn as suggested by the Office Action would improperly require the principle of operation of Dunn to be modified. As described previously, the displays in Dunn are intended to provide purely *commercial* information, *i.e.*, advertising and promotions for “the full features and facilities of the casino or establishment” as well as “other entertainment opportunities, tourist attractions, shopping facilities, traffic and travel information, and other information of current or future interest.” Dunn, col. 6, lines 22-34. As such, the displays are intended to promote the generation of revenue through other venues and activities unrelated to game play on the gaming machine. If the teachings of Wiltshire and Dunn were combined as suggested by the Office Action, the game selection indicia would be displayed in place of the promotional advertising. Replacing the promotional advertising would improperly modify the principle of operation of Dunn by preventing the generation of revenue through the promotion of other venues and activities. Accordingly, the teachings of Wiltshire and Dunn are not combinable to establish sufficient grounds for a *prima facie* case of obviousness. Thus, withdrawal of the rejection of claims 55, 57-60, 71-74 and 93-96 is in order and is respectfully requested.

4. Rejecting the claims based on the combination of Wiltshire and Dunn is the result of impermissible hindsight.

According to the *M.P.E.P.*, “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” *M.P.E.P.* § 2142. As discussed previously, neither Wiltshire nor Dunn teaches or suggests they each fail to teach or suggest displaying a plurality of game selection indicia corresponding to the plurality of games when a display terminal is idle, as recited by independent claims 5 and 71. In addition, there is no evidence that the results of combining the teachings of Wiltshire and Dunn would have been sufficiently predictable to produce the claimed inventions.

Furthermore, combining the teachings of Wiltshire and Dunn as suggested by the Office Action would improperly require the principle of operation of one of the references to be modified. The Office Action's attempt to stretch the teachings of Wiltshire and Dunn to arrive at the claimed invention where such teachings fail to exist suggests that the Office Action is applying impermissible hindsight. Indeed, as described previously, the Office Action's attempt to reach the claimed invention required an inaccurate reading of Dunn. Thus, withdrawal of the rejection of claims 55, 57-60, 71-74 and 93-96 is in order and is respectfully requested.

C. The rejection of claim 56 under 35 U.S.C. 103(a) as being unpatentable over Wiltshire in view of Dunn, and further in view of Thacher should be withdrawn.

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiltshire in view of Dunn, and further in view of Thacher. One basic requirement for a *prima facie* case of obviousness under 35 U.S.C. § 103(a) is that the prior art references must teach or suggest each and every element recited by the claims. *See, e.g., M.P.E.P. § 2143.* Applicants respectfully submit that dependent claim 56 is allowable, because the Office Action fails to establish that Thacher teaches or suggests displaying a plurality of game selection indicia corresponding to the plurality of games when a display terminal has been idle. *See* Office Action p. 10, line 5-p. 11, line 16. In other words, Thacher does not cure the deficiencies of Wiltshire and Dunn described previously. Thus, claim 56 is allowable at least for the same reason as its base claim 55. Withdrawal of the rejection of claim 56 is in order and is respectfully requested.

CONCLUSION

It is the Applicant's belief that all the pending claims are now in condition for allowance, and thus reconsideration of this application is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

No fees are believed due in connection with this amendment. However, the Commissioner is authorized to charge any fees which may be required in connection with this application (excluding the issue fee), or credit any overpayment to Deposit Account No. 50-4181, Order No. 247079-000087USC1.

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